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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/594,784

09/29/2006

Hideyuki Ono

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7590

08/20/2010

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EXAMINER

REDDY, KARUNA P

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

08/20/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/594,784	Applicant(s) ONO ET AL.	
	Examiner KARUNA P. REDDY	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 June 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,5,8,10,12 and 14-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 5, 8, 10, 12 and 14-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is in response to the amendment filed 6/23/2010. Claims 1 and 14 are amended; claims 2-4, 6-7, 9, 11 and 13 are cancelled. Accordingly, claims 1, 5, 8, 10, 12 and 14-16 are currently pending in the application.

Given that amendments do not affect the scope of instant claims and the grounds of rejection remain unchanged from that set forth in the preceding office action, it is proper to make this action final.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 103

3. Claims 1, 5, 8, 10 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aonuma et al (US 5,157,083).

The rejection is adequately set forth in paragraph 5 of office action mailed 3/23/2010 and incorporated here by reference.

4. Claims 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aonuma et al (US 5,157,083) in view of Moriyama et al (US 6,156,849).

The rejection is adequately set forth in paragraph 6 of office action mailed 3/23/2010 and incorporated here by reference.

Response to Arguments

5. The objections as set forth in paragraph 4 in the preceding office action mailed 3/23/2010 are hereby overcome in light of the amendments and applicant's arguments filed 6/23/2010.
6. Applicant's arguments filed 6/23/2010 have been fully considered but they are not persuasive. Specifically, applicant argues that (A) base polymers of instant (carboxyl group-containing acrylic rubber) and Aonuma et al (maleic anhydride (derivative)-modified, hydrogenated NBR) are completely different; (B) there are no examples in Aunoma et al, wherein sulfur vulcanization is performed; (C) in the present invention only a polyvalent amine compound is used as a vulcanizing agent. Polyvalent amine compounds and applicant's preferred p-substituted aromatic diamine are not disclosed as vulcanizing agents in Aonuma et al; (D) it is well known that N-substituted antiozonant, of Aunoma et al, has no "crosslinking" function, and aliphatic unsaturated dicarboxylic acid monoalkyl ester-copolymerized acrylic elastomer does not cause sulfur vulcanization. Examiner's reference to the use of sulfur containing vulcanization agent is not relevant; (E) applicant's improved compression set of test O ring having a 5-mm in wire diameter cannot be improved without the use of a thiazole-based compound; (F) in Aunoma et al, mercaptobenzothiazole, mercaptothiazole and the like are used as a vulcanizing accelerator together with a sulfur and/or sulfur donating compound, and not as instantly claimed anti-oxidant.

With respect to (A), instantly claims only require the acrylic elastomer composition to comprise aliphatic unsaturated dicarboxylic acid ester-copolymerized

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acrylic elastomer. Accordingly, Aunoma et al teach an acrylic elastomer composition comprising maleic anhydride copolymerized with NBR and meets the instant claim limitation.

With respect to (B), case law holds that "applicant must look to the whole reference for what it teaches. Applicant cannot merely rely on the examples and argue that the reference did not teach others." See *In re Courtright*, 377 F.2d 647, 153 USPQ 735,739 (CCPA 1967). Further, "nonpreferred disclosures can be used. A nonpreferred portion of a reference disclosure is just as significant as the preferred portion in assessing the patentability of claims." See *In re Nehrenberg*, 280 F.2d 161,126 USPQ 383 (CCPA 1960).

With respect to (C) and (F), firstly, while the instant claims use transitional phrase "consisting of" to limit the vulcanizing agent to "polyvalent amine compounds", instant claims also use the transitional phrase "comprising" to define the composition. Case law holds that transitional phrase "comprising" is inclusive or open-ended and does not exclude additional, unrecited elements. Hence, it is the examiner's position that instant claims are open to addition of other components. Secondly, while examples in instant application use "di-o-tolylguanidine vulcanization promoter" as a vulcanization promoter, Aunoma refers to the sulfur based compounds as vulcanizing agents. Case law holds that discovery of a new property or use of a previously known composition, even if unobvious from the prior art, cannot impart patentability to claims to a known composition. See *In re Spada* 15 USPQ 2d 1655 (CAFC 1990). It is well settled that recitation of a new intended use for an old product does not make a claim to that old product. See *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431(Fed Cir 1997).

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With respect to (D), firstly, examples in instant application use "di-o-tolylguanidine vulcanization promoter". Hence, it is clear sulfur containing compound participates in vulcanization of acrylic elastomer composition. Secondly, applicant's argument that N-substituted antiozonant, of Aunoma et al, has no "crosslinking" function, and aliphatic unsaturated dicarboxylic acid monoalkyl ester-copolymerized acrylic elastomer does not cause sulfur vulcanization, is a conclusory statement which is not supported by evidence i.e. attorney's statements are not a substitute for factual evidence.

With respect to (E), given that compositional requirements are met by the cited references, it is the examiner's position that improved compression set is exhibited by the composition of cited prior art.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KARUNA P. REDDY whose telephone number is (571)272-6566. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/K. P. R./
Examiner, Art Unit 1796

/Vasu Jagannathan/
Supervisory Patent Examiner, Art Unit 1796